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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/253,638	02/19/1999	KEISUKE OGURO	1217-990257	5855

7590 04/16/2002

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EXAMINER

ZITOMER, FRED

ART UNIT	PAPER NUMBER
1713	17

DATE MAILED: 04/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/253,638	Applicant(s) Oguro et al.	Examiner Fred Zitomer	Art Unit 1713	
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>					
Period for Reply					
<p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p>					
<ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 					
Status					
<p>1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Apr 2, 2002</u></p>					
<p>2a) <input type="checkbox"/> This action is FINAL. 2b) <input checked="" type="checkbox"/> This action is non-final.</p>					
<p>3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11; 453 O.G. 213.</p>					
Disposition of Claims					
<p>4) <input checked="" type="checkbox"/> Claim(s) <u>1-7</u> is/are pending in the application.</p>					
<p>4a) Of the above, claim(s) <u>2-7</u> is/are withdrawn from consideration.</p>					
<p>5) <input type="checkbox"/> Claim(s) _____ is/are allowed.</p>					
<p>6) <input checked="" type="checkbox"/> Claim(s) <u>1</u> is/are rejected.</p>					
<p>7) <input type="checkbox"/> Claim(s) _____ is/are objected to.</p>					
<p>8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.</p>					
Application Papers					
<p>9) <input type="checkbox"/> The specification is objected to by the Examiner.</p>					
<p>10) <input type="checkbox"/> The drawing(s) filed on _____ is/are objected to by the Examiner.</p>					
<p>11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved.</p>					
<p>12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>					
Priority under 35 U.S.C. § 119					
<p>13) <input checked="" type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).</p>					
<p>a) <input checked="" type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:</p>					
<p>1. <input checked="" type="checkbox"/> Certified copies of the priority documents have been received.</p>					
<p>2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</p>					
<p>3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p>					
<p>*See the attached detailed Office action for a list of the certified copies not received.</p>					
<p>14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).</p>					
Attachment(s)					
<p>15) <input type="checkbox"/> Notice of References Cited (PTO-892)</p>			<p>18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____</p>		
<p>16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p>			<p>19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p>		
<p>17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). <u>15</u></p>			<p>20) <input type="checkbox"/> Other: _____</p>		

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1.

The request filed on April 2, 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/253,638 is acceptable and a CPA has been established. An action on the CPA follows.

2.

This responds to the communication of February 28, 2002. The rejection of record of claim 1 under 35 U.S.C. 103(a) over Shahinpoor et al, WO 97/26039, alone or taken with Nidola et al. is maintained as stated below. No claim is allowed.

3.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shahinpoor et al, WO 97/26039, alone or taken with Nidola et al., US 4364,803.

Shahinpoor teaches preparing polymeric actuators by conducting present steps (I) to (iii) [page 3, line 24 - page 7, line 18]. The options of changing the order and/or repeating steps corresponding to present steps (ii) to (iii) are disclosed [see e.g. page 7, lines 12-13; page 6, lines 8-11; page 5, lines 6-30; claim 82]. Nidola teaches controlling the amount of metal deposited on the surface of ion exchange resins during reductive deposition, i.e. present step (I), by repeating the step of adsorbing metal complexes [Abstract, paragraph 3; column 5, lines 1-14; Example 1].

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Shahinpoor differs from the instant invention by not disclosing that the step of adsorbing metal complexes can be repeated.

It would have been obvious to repeat the step of allowing an ion exchange resin to adsorb a metal complex because it is well settled that a result oriented variable implemented within the skill of the art to solve a known problem in a known process is obvious absent the showing of a new or unexpected result. *In re Boesch*, 205 USPQ 215. In the present case it is generally known to regulate the amount of metal deposited by controlling parameters such as concentration, contact time, temperature, and the number of cycles.

In the alternative, it would have been obvious to control the amount of metal deposited on an ion exchange resin by repeating the metal complex absorption step because Nidola teaches the embodiment for depositing the same metals on the same ion exchange resins as Shahinpoor.

5.

Applicant's arguments filed September 17, 2001 have been fully considered but they are not persuasive.

The argument that the references fail to teach repeating the instant processing steps has been addressed in prior Office actions. The key point remains that it would be obvious to expect the repetition of steps (I) and (ii) to increase the amount of metal deposited and the purity thereof. More directly, it is axiomatic that the amount of metal deposited, i.e. steps (I and ii), is directly proportional to the time of deposition and the more times a material is washed, i.e. (step iii), the purer the resultant product will be.

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By way of reply to the argument that the references fail to disclose the claimed thickness ratios, it is well settled that differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. *MPEP 2144.05 II A.* In the present case:

- nothing on this record shows that the amount of metal deposited is other than an optimization based on the need at hand.
- nothing on this record shows that the prior art teaches away from the amount of metal deposition being claimed.
- it has been held that the mere duplication of parts has no patentable significance unless a new or unexpected result is produced. *MPEP 2144.04 B.* By analogy in the present case, nothing on this record shows that increasing the amount of metal deposition by repetition is critical versus extending the time of deposition and/or the concentration of the adsorption and/or deposition solutions.

In regard to applicant's argument that Nidola fails to address the bending or deformation of actuators it is noted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to

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Fred Zitomer whose telephone number is (703) 308-2461. The examiner can normally be reached Monday through Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful David Wu can be reached at (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 (before final) and (703) 872-9311 (after final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



FRED ZITOMER, PHD
PRIMARY EXAMINER
ART UNIT 1713

Zitomer/fz
April 12, 2002